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7590 12/26/2007 Michael E. Carmen, Esq. M. CARMEN, ASSOCIATES, PLLC 170 Old Country Road Suite 400 Mineola, NY 11501				
EXAMINER WALLENHORST, MAUREEN				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT H. WOLLENBERG  
and THOMAS J. BALK

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Appeal No. 2007-0495  
Application No. 10/699,510

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Decided: 26 December 2007

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Before FRED E. McKELVEY, *Senior Administrative Patent Judge*, and  
ADRIENE LEPIANE HANLON and MICHAEL P. TIERNEY,  
*Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON REHEARING

The Appellants request rehearing of a Decision on Appeal mailed March 28, 2007. The Decision affirmed the rejection of claims 1-4 and 6-22 under 35 U.S.C. § 103(a) as unpatentable over Kolosov and the rejection of claims 5 and 23-37 under 35 U.S.C. § 103(a) as unpatentable over the combination of Kolosov and Shtein.

A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied on in the briefs are not permitted in the request for

rehearing except as permitted by 37 C.F.R. § 41.52(a)(2) and (3). *See* 37 C.F.R. § 41.52(a)(1) (2007).

A. Claims 1-4 and 6-22

Claim 1 recites a method for preparing a plurality of different lubricant oil formulations including the step of:

- a) providing a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive for combination to formulate a lubricating oil composition.

The Board found that the material samples disclosed in Kolosov include lubricant compositions comprising a lubricant and an additive. Decision 6, 10. The Board found that Kolosov does not disclose that the lubricant compositions contain a minor amount of an additive. Decision 9. Indeed, Kolosov is silent as to the additive amount in the disclosed lubricant compositions.

Nevertheless, the Board pointed to the examiner's finding that an additive, by definition, means any substance incorporated into a base material, *usually* in a low concentration, to perform a specific function, i.e., a stabilizer, preservative, dispersing agent, antioxidant, etc. *See The Condensed Chemical Dictionary* 20 (10<sup>th</sup> ed. 1981). The Board noted that the Appellants did not challenge this finding. Decision 9-10.

Based on this definition of "additive," the Board found that "one of ordinary skill in the art would have expected the lubricant compositions [in Kolosov], comprising a lubricant and an additive, to have a major amount of a base oil and a minor amount of an additive." Decision 10.

The Appellants argue that "a lubricating oil composition can be a concentrate that contains a major amount of a lubricating oil additive and a

minor amount of base oil of lubricating viscosity as a diluent for the concentrate.” The Appellants argue that this argument was overlooked on appeal. The Appellants also point to *Chemistry and Technology of Lubricants* 88 (R.M. Mortier & S.T. Orszulik, eds., 2nd ed. 1997) for the first time on appeal to support their argument. Request 2-3.

First, *Chemistry and Technology of Lubricants* is not entitled to consideration on rehearing. 37 C.F.R. § 41.52(a)(1) (2007). Second, it does not appear that the Appellants presented this argument in either the Appeal Brief or the Reply Brief. See App. Br. 9 (arguing that “a lubricating oil composition can be a concentrate that contains a major amount of a *lubricating oil composition* and a minor amount of a base oil of lubricating viscosity” (emphasis added)). Suffice it to say that, on rehearing, the Appellants have failed to explain why one of ordinary skill in the art would not have expected the additives disclosed in Kolosov to be present in a minor amount, especially in view of the examiner’s finding that an additive is *usually* incorporated into a base material in a low concentration. The Appellants mere offer of an alternative definition for “additive” does not sufficiently explain why, in the context of the Kolosov invention, the Board erred.

Apparently relying on this alternative definition of “additive,” the Appellants generally argue that a lubricating composition containing an additive cannot *inherently* contain a major amount of a base oil and a minor amount of an additive. Request 2. However, the Board did not find that the lubricating composition disclosed in Kolosov inherently contains a major amount of a base oil and a minor amount of an additive. See Decision 10.

B. Claim 5

The Appellants argue that several arguments with respect to the rejection of claim 5 were overlooked. Request 3-5.

The Appellants did not argue the rejection of claim 5 separately in the Appeal Brief. Therefore, any arguments relating to the rejection are not entitled to consideration on rehearing. 37 C.F.R. § 41.52(a)(1) (2007).

C. Claims 23-37

Claim 23 recites a system for preparing a plurality of lubricant oil formulations including:

- d) means for combining selected quantities of the at least one base oil of lubricating viscosity with selected quantities of the at least one lubricating oil additive to form a plurality of lubricating oil composition samples.

The Board concluded that the “means for combining” is a mixing chamber wherein the base oil and additive are combined prior to dispensing. Decision 10.

The Board found that Kolosov discloses that the samples may be dispensed with any suitable dispensing apparatus. The Board found that Shtein discloses an apparatus for depositing organic material on a substrate using a carrier gas. The Board found that the Shtein apparatus uses a mixing chamber to mix the organic material and a carrier gas prior to deposition on the substrate. Decision 7-8.

The Appellants argue that there would have been no motivation to combine the teachings of Kolosov and Shtein because Shtein does not mix liquid solvents in the disclosed mixing chamber. Request 5.

This point was addressed on pages 11-12 of the Decision. Namely, the Board relied on Shtein to establish that “one of ordinary skill in the art

would have recognized that a mixing chamber, such as the mixing chamber disclosed in Shtein, would have been an efficient and effective means for mixing materials, such as a lubricant and an additive, prior to dispensing.” *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). On rehearing, the Appellants have failed to point to any error in the Board’s finding.

#### Conclusion

The Appellants’ request for rehearing has been granted to the extent that the Decision on Appeal mailed March 28, 2007, has been reconsidered in light of the Appellants’ arguments. However, the request is denied because we decline to modify the decision in any respect.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

#### REHEARING DENIED

Appeal No. 2007-0495  
Application 10/699,510

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